

REMARKS

Applicant is filing this Amendment and Response in response to a Final Official Action dated January 30, 2007. At the time of the Office Action, claims 1-10 and 12-33 were pending. In this Response and Amendment, claims 1-3, 5-7, 10, 12, 14-16, 19-21, 23-26 and 29-31 are amended. No new claims are added, but claim 27 is canceled. Accordingly, claims 1-10, 12-26 and 28-33 are currently pending.

Summary of the Rejections

In the Final Office Action, claims 1, 2, 5-7, 19, 20, 23-27, and 29-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,088,033 to Binkley et al. ("the Binkley reference"). Claims 3, 8, 9, 21, 32 and 33 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley in view of Van Ee et al., U.S. Patent No. 6,937,972 to Van Ee et al. ("the Van Ee reference"). Claims 4, 22 and 28 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley as applied to claims 1, 19 and 16 above, in view of Burg et al., U.S. Patent No. 6,456,699 to Burg et al. ("the Burg reference"). Claims 10, 12, and 14-17 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley in view of Stockburger et al., ("Virtual Onside Support: Using Internet Chat and Remote Control to Improve Customer Service," Proceedings of the 30th Annual ACM SIGUCCS Conference on User Services, Providence, Rhode Island, pages: 143-147, 2002), ("the Stockburger reference"). Claim 13 was rejected under 35 U.S.C. 103(a) as being obvious over Binkley as modified by Stockburger as applied to claim 10 above, and further in view of Berg et al. Claim 18 was rejected under 35 U.S.C. 103(a) as being obvious over Binkley in view of Stockburger as applied to claim 10 above, and further in view of Van Eu. Each of these rejections is addressed in detail below.

The Rejection Under 35 U.S.C. § 102(b)

With respect to the rejection of independent claims 1, 19 and 26 under Section 102 based on Binkley, the Examiner stated:

4. Claims 1,2, 5-7, 19, 20, 23-27, 29-31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Binkley et al (US Patent 5,088,033).

5. As to Claims 1, 19, 26 and 34, Binkley et al teaches: a system, comprising: at least one device information file that contains emulation information about at least one device (column 28, lines 35-50; column 31, lines 1-8); and an emulator that is adapted to read the at least one device information file and provide an on-screen display ("OSD") emulation of the at least one device corresponding to the selected one of the plurality of device information files, wherein the emulation information of the at least one device is contained in the selected one of the plurality of device information files (column 7, lines 39-43; column 8, line 60-column 10, line 21, Figure 5, elements 82 and 84; column 29, lines 61-68)..

Office Action, pp. 2, 3.

Legal Precedent

The Applicant respectfully traverses the rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the

cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

In the present case, the Binkley reference does not anticipate the Applicant’s claims under Section 102 because every element of the claimed invention is not identically shown in the Binkley reference. Specifically, independent claim 1 recites an emulator that is adapted to provide an on-screen display (“OSD”) emulation “*having characteristics of a visual display associated with the device based on the emulation information contained in the selected one of the plurality of device information files.*” (Emphasis added). Independent claim 19 recites a system that comprises means for performing an OSD emulation “*having characteristics of a visual display associated with the device whose emulation information is contained in a selected one of the plurality of device information files.*” (Emphasis added). Independent claim 26 recites a tangible machine-readable medium that comprises machine-readable code comprising an emulator program that provides an OSD emulation “*having characteristics of a visual display associated with a set-up procedure of the device whose emulation information is contained in the selected one of the plurality of device information files.*” (Emphasis added). Accordingly, independent claims 1, 19 and 26 each relate to the presentation of an OSD emulation in which individual visual display characteristics are emulation information contained in device information files. In other words, the emulation information relates to display characteristics of a particular device. Exemplary embodiments of the present invention may allow remote users, such as call center operators and the like, to reproduce a visual display or other feedback that a customer sees or otherwise receives when

the customer is trying to set up a newly purchased device, such as a computer system or computer monitor.

In contrast to the Applicant's claims, the Binkley reference discloses a system which is modified to include an additional processor configured to execute software otherwise poorly or not executable at all by the original unmodified system. Particularly, the Binkley reference discloses:

The present invention combines a host system with an emulating processor which is capable of running software written for a target system. The emulating processor is added so as not to prevent the host system CPU from performing its own independent operations...

Binkley, col. 1, lines 60- 64.

Binkley further discloses:

The emulating processor is thus added in a manner which protects the host system CPU from crashes in the target system software, since the host system CPU is not executing the software which leads to the crash and may continue with its independent operation.

Binkley, col. 2, lines 5-9.

Hence, emulation, as disclosed in Binkley, requires an added processor to augment a system's performance in executing particular software. Binkley does not teach, suggest or illustrate a system in which information about the visual display characteristics of a plurality of devices are provided in a user-selectable manner. At best, the Binkley reference discloses a host CPU adapted for emulating devices such as, input/output (I/O) devices, floppy disks drives, keyboard, printers and so forth. *See*, Binkley, col. 8, lines 60-64. However, the Binkley reference clearly fails to disclose how emulation information can be used to provide

emulations having a variety of different visual display characteristics, as recited in independent claims 1, 19 and 26. Therefore, the Binkley reference does not disclose a system or method that meets every limitation recited in independent claims 1, 19 or 26.

For at least these reasons, the Applicant respectfully submits that independent claims 1, 19 and 26 (and the claims dependent thereon) are not anticipated by the Binkley reference. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claims 1, 2, 5-7, 19, 20, 23-27, 29-31 and 34 under Section 102 based on Binkley.

The Rejections Under 35 U.S.C. § 103

As set forth above, claims 10-12 and 14-17 were rejected under 35 U.S.C. § 103 as being rendered obvious by Binkley in view of Stockburger. With respect to independent claim 10, the Examiner stated:

23. Claims 10-12, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binkley et al in view of Stockburger et al ("Virtual Onsite Support: Using Internet Chat and Remote Control to Improve Customer Service", Proceedings of the 30th Annual ACM SIGUCCS Conference on User Services, Providence, Rhode Island, pages: 143 - 147, 2002).

24. Binkley et al teaches: (claim 10) identifying a device information file that comprises emulation information about a set-up procedure associated with at least one device (column 28, lines 35-50; column 31, lines 1-8); (claim 10) invoking an emulator that is adapted to access the device information file and provide an emulation that is based on the emulation information (column 7, lines 13-16; column 7, lines 39-43; column 30, line 58-column 31, line 15); (claim 11) providing an on-screen display ("OSD") emulation based on the emulation information (column 7, lines 13-16; column 7, lines 39-43); (claim 12) defining the emulation to be presented in a manner that approximates an output provided by the at least one device (column 7, lines 39-56); (claim 14) defining the at least one device to comprise a computer display device (Figure

2, element 22b; column 7, lines 39-43); (claim 15) defining the at least one device to comprise a computer system (Figure 2, element 22); (claim 16) defining the at least one device to comprise a consumer electronics device (Figure 2, elements 22, 22a, 22b, 22c, 24, 26, 28).

25. Binkley et al does not expressly teach: (claim 10) providing instruction to a user based on the emulation; (claim 17) accessing the emulator via a network.

26. Stockburger et al teaches the use of a remote control utility that is a useful tool for the staff of a Help Desk, enabling the staff to get problems fixed in a matter of minutes instead of hours, and allowing the customer to learn something in the process, therefore, contributing to an improved image of the Help Desk and the IT Department of a facility (Conclusion, paragraph 1, lines 3-8). Stockburger et al teaches that the customer can share their screen, or give complete control of their screen to the help desk technician (Abstract, last paragraph, lines 6-9), which sets up an emulation of the customer's computer on the technician's computer via a network (Abstract, last paragraph, lines 5-9; page 145, paragraph 3; see figure on page 146, and description, page 145, paragraph 2) and allows the technician to provide instruction to a user based on the emulation (page 146-147, last bullet).

27. Binkley et al and Stockburger et al are analogous art since they are both directed to the emulation of an electronic device and providing an on-screen display of the emulated device.

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device emulation and on-screen display of the emulated device as taught by Binkley et al to include providing instruction to a user based on the emulation as taught by Stockburger et al since Stockburger et al teaches the use of a remote control utility that is a useful tool for the staff of a Help Desk, enabling the staff to get problems fixed in a matter of minutes instead of hours, and allowing the customer to learn something in the process, therefore, contributing to an improved image of the Help Desk and the IT Department of a facility (Conclusion, paragraph 1, lines 3-8).

Office Action, pp.6-8.

Legal Precedent

The Applicant respectfully traverses the rejection. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

The rejection of independent claim 10 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of independent claims 1, 19 and 26 under Section 102. Independent claim 10 recites a process in which an emulator is invoked to provide an OSD emulation “*having characteristics of a visual display of the device associated with the emulation information* contained in a selected one of the plurality of device information files....” (Emphasis added).

As set forth above, neither Binkley nor the supporting reference Stockburger discloses a method in which the visual display characteristics of a plurality of different devices are contained in selectable device information files. This means that, by definition, neither Binkley nor Stockburger disclose providing instruction to a user based on such an OSD emulation, as further recited by independent claim 10. Accordingly, the combination of the Binkley reference and the Stockburger reference cannot render the Applicant's claims obvious. The Applicant therefore respectfully asserts that the rejection of independent claim 10 and claims dependent therefrom under Section 103 is erroneous and should be withdrawn.

Rejection of Dependent Claims Under Section 103

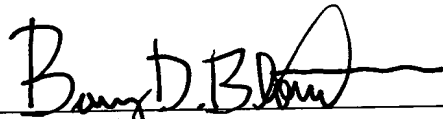
The Examiner rejected dependent claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33 under 35 U.S.C. § 103(a) as obvious over the Binkley reference in view of other secondary references. Applicant respectfully traverses these rejections. Moreover, Applicant respectfully submits that claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33 are allowable based on their dependencies from independent claims 1, 10, 19 and 26 because the secondary references do not cure the deficiencies described above in regard to the Binkley reference. Indeed, it is not even asserted by the Examiner that the secondary references remedy the deficiencies set forth with respect to Binkley. For at least these reasons, Applicant respectfully asserts that the Examiner has clearly not established a *prima facie* case of obviousness with regard to independent claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33. Accordingly, Applicants respectfully request the withdrawal of the rejections of those claims under Section 103.

Conclusion

In view of the remarks set forth above, the Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims 1-10 and 12-26 and 28-33. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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